

REMARKS

In the Office Action mailed April 1, 2008, the Office Action rejected claims 11 and 21-24. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled in view of the prior art. In addition to the arguments listed below Applicants have amended claim 11 and added claims 25-34 to further distinguish the present invention from the art of record. Furthermore, Applicants believe that the amendments clarify the differences between the present invention and Stegmann because it has not been shown where Stegmann is implanted in an eye.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

I. Examiner Telephone Interview

Applicants would like to thank Examiner Isis A. Ghali for the time and courtesy extended to Applicants' Representative Daniel Aleksynas during a telephonic interview conducted on August 10, 2009. In that interview the Stegmann reference was discussed. Specifically, the proposed modification, and how it would render the device unsatisfactory for its intended purpose, as detailed below, was discussed. Examiner Ghali indicated that the arguments appeared to be persuasive, and that she would take them under consideration.

II. Amendment to Claim 11

Claim 11 has been amended to further distinguish over the art of record. No new matter has been added. Support for the amendments under 35 U.S.C. § 112 can be found in U.S. Patent Application Publication 2005/0008673 at paragraph 0044 and Figure 1.

III. New Claims

Applicants added new claims 25 - 34. No new matter has been added. Support for the amendments under 35 U.S.C. § 112 can be found in U.S. Patent Application Publication 2005/0008673 at paragraph 0043, Figures 1, 4, and 5, and currently pending claims 21-24.

IV. Claim Rejections Under 35 U.S.C. § 112

The Office Action rejected claims 22 and 24 under 35 U.S.C. § 112. Without acquiescence to this suggestion Applicants have amended claims 22 and 24. Applicants believe that the rejections are moot in view of these amendments and respectfully request that the rejections are withdrawn. Further, Applicants point out that the term mass is defined in The American Heritage Dictionary as, "A unified body of matter with no specific shape" A person skilled in the art would understand the meaning of the term mass as used in claim 22.

V. Claim Rejections Under 35 U.S.C. § 103

The Office Action rejected claims 11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over 5,360,399 combined with 7,354,574. The Office Action rejected claim 22 as being unpatentable over 5,360,399 combined with 7,354,574 and further in view of 4,743,255. The Office Action rejected claim 23 as being unpatentable over 5,360,399 combined with 7,354,574 and further in view of 6,692,759. The Office Action rejected claim 24 as being unpatentable over 5,360,399 combined with 7,354,574 and further in view of 5,512,055.

a) Incorrect Fact Findings and Lack of Evidence

Applicants believe the rejections are based upon insufficient fact finding. The facts as set forth below show that a rejection using these references cannot be maintained. The claimed invention performs two functions and neither of these functions are adequately addressed by the Office Action. First, the shunt provides a dynamic flow path to accommodate a fluid flow to relieve ocular pressure and this flow path is created by a passive device without the addition of pressure to create a flow path. Second, the shunt acts as a sustained medication delivery device—not a one time delivery of medication

Furthermore, the Office Action has not presented facts as to every element of the present invention. The Office Action fails to point out in the art of record where any the art teaches "a first end located in a first portion of an eye and a second end located in a second portion of the eye."

The Office Action also fails to show where the art of record teaches "a solid material." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) (Stating that, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.")

b) Modification Will Render the Prior Art Unsatisfactory for Its Intended Purpose

As set forth in MPEP 2143.01 THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE. Foremost, Applicants would like to renew the arguments made in the Pre-Appeal Brief stating why the present invention is not obvious in view of Stegmann. Furthermore, the arguments made in the Pre-Appeal Brief are not directed to the intended use of the invention; the arguments explain that if the proposed modifications were made to the device taught in Stegmann the device would be **rendered unsatisfactory for its intended purpose**.

The modifications to Stegmann (U.S. Patent No. 5,360,399) in view of Peyman 7,354,574 as suggested by the Office Action would render the resulting structure unsuitable for its intended purpose. The Office Action has failed to show how the Stegman apparatus can be modified to achieve the claimed result without eliminating the critical element taught in Stegmann—the hydraulic expansion and traumatic opening of the upstream tissue of the Schlemm's canal. Stegmann cannot be implanted in an eye as suggested by the Office Action, by combining Stegmann with Peyman, and continue to perform its intended purpose. For Example, how does the Office Action propose to have **"a first end located in a first portion of an eye and a second end located in a second portion of the eye,"** and still be able to inject the viscous fluid through the device taught in Stegmann? Both ends of Stegmann cannot be placed in the eye, as claimed, without rendering the device taught in Stegmann unsatisfactory for its intended purpose. Furthermore, Stegmann injects a viscous medium into the eye; how can the Office Action reconcile this with Peyman where the medium (i.e. drug) is time released? Moreover, the claim states that **"the sustained release medium comprises a solid material."** If the medium placed in the eye is a solid; how can it be forced through the device taught in Stegman and achieve the results Stegmann teaches?

The Office Action appears to suggest that there is motivation for combining Peyman and Stegmann. However, Stegmann does not have any teaching, suggestion, or motivation that discusses having both ends located in the eye, using a solid material, or time releasing a medium. If Stegmann was modified to have both ends implanted, use a solid material, or to

use a time release medium the device of Stegmann would not perform its intended purpose; therefore, the combination of the two devices is improper.

See *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). See also *In re Fritch* (CA FC 1992) 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992)("The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification").

CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,

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